REMARKS

In an Office Action mailed on November 6, 2003, the Examiner reopened prosecution; claims 1-8 and 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over alleged Applicant's Admitted Prior Art (herein called "AAPA") in view of Lang; and claims 9-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Lang and further in view of Banker, Andersson or Julyan. These rejections are addressed below.

The Examiner fails to establish a *prima facie* case of obviousness for any of the claims for at least two reasons. First, even assuming that the combination of AAPA and Lang is proper, the combination of these references fails to teach or suggest all claim limitations. For example, the method of claim 1 recites buffering bits to accommodate a difference between a first rate of incoming data and a second rate of outgoing data. The Examiner relies on Lang for these limitations. However, contrary to the limitations of claim 1, Lang teaches a FIFO buffer 201 whose input data is clocked at the same rate as its output data. More specifically, Lang teaches that the FIFO buffer 204, "is implemented by a 1-bit wide, 12-bit long shift-register clocked by a bit rate clock recovered by the receiver from received digital stream 90." Lang, 5:48-51. Thus, in Lang's system, the FIFO is a shift register in which there is no difference between the rates of the incoming and outgoing data. Contrary to the limitations of claim 1, Lang neither teaches nor suggests that the FIFO buffers bits to accommodate a difference between a first rate of incoming data and a second rate of outgoing data. Rather, Lang teaches that these rates are the same in its system. Therefore, for at least the reason that the combination of Lang and the AAPA fails to teach or suggest all claim limitations, a *prima facie* case of obviousness has not been established for independent claim 1.

For at least the same reasons, the Examiner fails to establish a *prima facie* case of obviousness for either independent claim 8 or independent claim 15. More specifically, the repeater of claim 8 includes a data recovery circuit that buffers bits to accommodate a difference between a first rate of incoming data and a second rate of outgoing data. Neither Lang nor the AAPA teaches or suggests such a data recovery circuit, for the at least the reasons set forth above; therefore, a *prima facie* case of obviousness has not been established for independent claim 8. Regarding claim 15, the system of claim 15 includes a repeater that buffers bits to

accommodate a difference between a first rate of incoming data and a second rate of outgoing data. These limitations are neither taught nor suggested by either Lang or the AAPA; therefore, the Examiner fails to establish a *prima facie* case of obviousness for independent claim 15.

The Examiner fails to establish a *prima facie* case of obviousness for either independent claims 1, 8 or 15 for at least the additional, independent reason that the AAPA teaches away from the claimed invention. More specifically, as set forth in the previous replies and in the previously filed appeal brief, the Background section (the related AAPA) of the application teaches away from detecting whether bits indicate a synchronization field *during* the buffering of the bits to accommodate incoming and outgoing data rates, as the Background section discloses performing the synchronization field detection *after* this buffering. It is improper to reject a claim under § 103 when one of the references relied on for the rejection teaches away from the claimed invention. M.P.E.P. § 2145.X.D. Thus, for at least this additional, independent reason, a *prima facie* case of obviousness has not been established for either claim 1, 8 or 15.

The Examiner fails to establish a *prima facie* case of obviousness for claims 1, 8 and 15 for at least the additional, independent reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation to combine Lang and the AAPA. Such a suggestion or motivation must be shown with specific citations to a prior art reference. *See Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (Bd. Pat. App. & Int. 2001); *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2143. Thus, because the Examiner fails to show where the prior art allegedly contains the suggestion or motivation to combine Lang and the AAPA, a *prima facie* case of obviousness has not been established for claims 1, 8 and 15 for at least this additional, independent reason.

Claims 2-7, 9-14 and 16-20 are patentable for at least the reason that these claims depend from allowable claims.

CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0327US).

Respectfully submitted,

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